HONEYWELL'S CLOSING **STATEMENT** PART 2 OF 2

21

and Unavailing

In the obviousness context

"Most inventions arise from a combination of old elements and each element may often be found in the prior art."

In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006) (citing In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)).

"cannot pick and choose among the individual elements of assorted prior art references to It is well-settled that the accused infringer recreate the claimed invention." SmithKline Diagnostics, Inc., v. Helena Labs. Corp., 859 F.2d 878, 887 (Fed. Cir. 1988)

Sundstrand's Use of Hindsight Improper and Unavailing

No surge control system existed in 1982-83 (however they are defined) found in the that had the combination of features APS 3200. (HON ¶168)

No evidence of combination other than via hindsight.

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Disputed Issue

references without proving motivation Whether Sundstrand may combine

-No. Sundstrand must, but did not, demonstrate motivation. (HON ¶ 194-196.)

Filed 05/10/2006

(HON ¶198.) Honeywell proved no motivation existed

control system was "state-of-the-art" in Indeed, because L1011 APU surge 1982-83, no motivation existed.

(HON ¶177.)

Disputed Issue

(HSC ¶77.) Sundstrand argues that the APS 3200 surge control system was developed between late 1989 and late 1993.

- This is not correct.

 As late as 1994, considered moving static (HON ¶50.) pressure sensors to eliminate the double solution.

(HON ¶41-51.) The infringing equivalent was not developed until 1995.

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APS 3200's Long Development History Confirms It Was Unforeseeable

product that employed the patented technology is • An accused infringer's failures in the design of a evidence suggesting nonobviousness.

946 F.2d 821, 835 (Fed. Cir. 1991) Intel Corp. v. U.S. Int'l Trade Comm'n,

evidence--the kind that can't be bought from a hired "If people are clamoring for a solution, and the best memories or doubtful inferences--of the state of expert, the kind that does not depend on fallible minds do not find it for years, that is practical knowledge."

831 F.Supp. 1354, 1378 (N.D.III. 1993) (Easterbrook, J.), aff'd 71 F.3d 1573 (Fed. Cir.1995) In the Matter of Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation,

Sundstrand Testimony Establishes That Equivalent Was Not "Readily Known" in 1982-83

encompassing readily known equivalents." language, may be expected to draft claims "The patentee, as the author of the claim

Festo, 535 U.S. at 740 (emphasis added)

known in the relevant art, then it would not represents . . . technology that was not "[U]sually if the alleged equivalent have been foreseeable."

Filed 05/10/2006

Festo, 344 F.3d at 1369

Tangential Relation

The "tangential relation" prong of the Festo bear[s] no more than a tangential relation to <u>rationale</u> underlying the amendment [] rebuttal test focuses on whether "the the equivalent in question." Festo, 535 U.S. at 740.

narrowing amendment was peripheral, or The test "asks whether the reason for the not directly relevant, to the alleged equivalent." Festo, 344 F.3d at 1369.

Festo, 344 F.3d at 1369 (emphasis added).

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Tangential Relation Inquiry Is Based Solely on the Patent File

which, "should be discernible from the The inquiry "focuses on the patentee's objectively apparent reason for the narrowing amendment," a reason prosecution history record." (HON ¶218.)

No Dispute: Tangential Relation

Examiner or Honeywell during prosecution. Neither the APS 3200 surge control system nor IGV position were mentioned by

The Examiner never rejected the disputed claims on prior art grounds. (HON ¶¶22, 24, 36.)

Filed 05/10/2006

The Examiner allowed claims that lacked IGV position.

(HON ¶23.)

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No Dispute: Tangential Relation

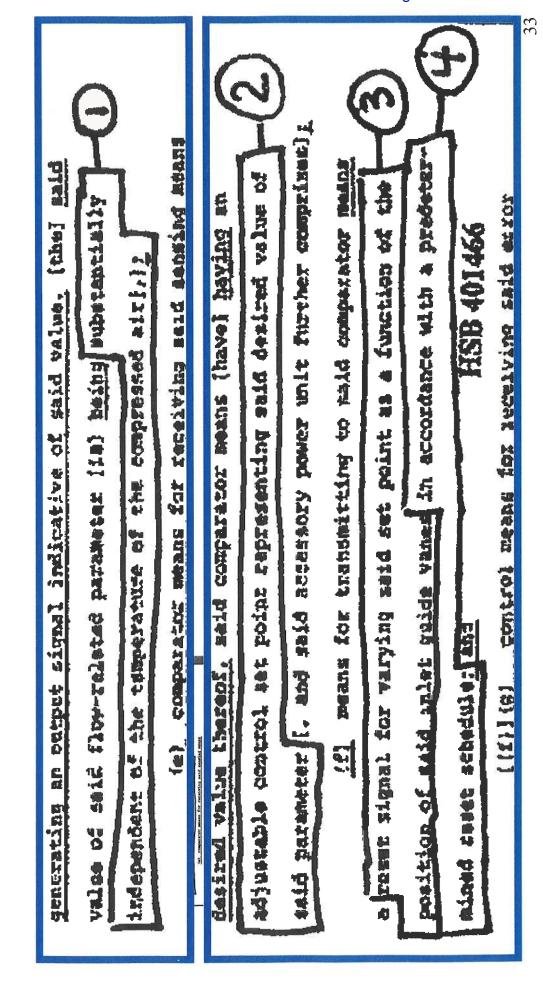
Honeywell rewrote dependent claims independent form, as Examiner to which Examiner objected in requested. (HON ¶\$22-24, HSC ¶\$59-61.)

This is the "objectively apparent" reason for the amendments.

More Than Just IGV to Claim 8 No Dispute: Honeywell Added

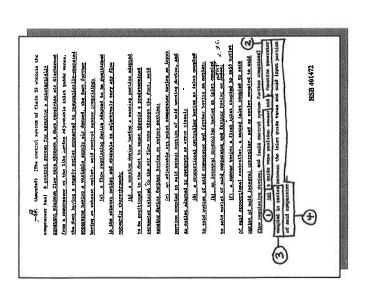
- temperature of the compressed air" "substantially independent of the
- representing the said desired value of "adjustable control set point said parameter"
- Sundstrand calls the "IGV Limitation" Neither limitation is part of 8(f), what

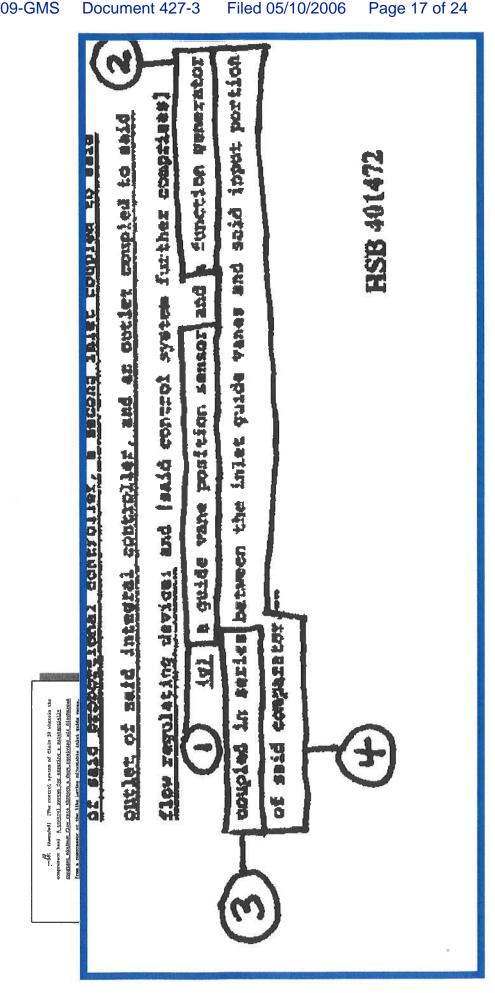
(HSC¶ 287)



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- Application Claim 35 (Claim 19 of (863)
- "a guide vane position sensor"
- "a function generator"
- "coupled in series"
- 4. "between the inlet guide vanes and said input portion of said comparator."





- Application Claim 51 (Claim 4 of '194)
- 1. "adjustable inlet guide vanes"
- parameter variations as a function of the relationship between the magnitudes of said integral and proportional control a control system that "adjust[s] the signals and the magnitudes of said position of the inlet guide vanes."

Document 427-3

Honeywell Amendment Also Adds Multiple Limitations to Claim 4

4. - sty-themend) (The) 2 nothed of iClaim 49 wherein utilizing apoarture huving a veriable inlet air flow dwannd, the compressor (has) having beljustable inlet guide vanes and metod chapmailes a dompressed of a gan turbles engine to posset pasumatically-ope

IN KANATH DISCRIPTION OF THOSE OF THE CHAPTERINE.

done from east, despite liveteakings in the flow sets of air received by the propertically-operated apparatur, by schausting sir from said Sens said supply duct being related to the magnitude of unid patement valus urziarions in houd. a proportumai and cime-foregraf commer. eaid, maincaining symp inginaing the cumps of providempoly dust is zagponne to varietions thebain of the vilue of a pre-(c) nainteaining an ossentially constant aminus supply determined, flow-related personains, the slow sets of air exhauster

outlet passage a surge bleed valve operable to solectavely resy th flow of eir ontwardly through said outlet passage, dentrating an his er antler passign from anid supply duct, bocitioning in said errones to said narizzione in said flow-related papeneter, and thing isometry of the faterity and proportional courts incopral control signal in response to said variation in said signals to operate said surge blood valve: and

intions as a function of the position of the inlot quade Venes. ** (d) | said mathod further comprises the step of | adjustattional control eignals and the impartuides of said persecter the relationship butween the negativates of said integral and

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4.—637-formed) (The) A seriod of iclais 19 stored auditoring amorganisation of the action and the second of the se

a compressed of a gas turbing engine to power preumatically-operate.

aposteets having a variable inlet air flow decand, the compressor

thes! having pd;usimble inlet quide venes isid nected compressing

the steps of

(d) | said method further comprises the stop of | adjust-

proportional control nignals and the magnatudes of said parameter ting the relationship between the magnitudes of said integral and

variations as a function of the position of the inlat guide vanes. 40

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Sundstrand's Articulation of the Rationale for the Amendments is Improper

(HSC ¶280.) amendment of all of the asserted claims was Sundstrand claims the "rationale behind the to add the IGV limitation to overcome the examiner's prior art rejection and gain allowance of the claims."

- Honeywell added more than just IGV use

The prosecution history establishes that IGV was not key to allowance Improperly conflates subject matter of amendment with rationale for amendment

(HON ¶24.)

IGV Position Limitation Was Added to Overcome a Non-Prior Art Objection

Examiner states that dependent Claims 17, 35 and 51 will be allowed if rewritten in independent form (HON ¶22.)

independent form effectively adding multiple In response Honeywell rewrote these in limitations, including IGV position

the *non*-prior art *objection* to the dependent claims Thus, these limitations were added in response to being dependent on rejected independent claims

370 F.3d at 1144.

Sundstrand Ignores CAFC Guidance

- added the term that is subject of equivalents dispute Truism in all Festo rebuttal cases that amendment
- Were that enough to defeat the tangential relation test, it would be an impossible standard.

Cordis, 336 F.Supp.2d at 369-70 (Robinson, C.J.)

CAFC in this case held that IGV was "effectively add[ed]" to the invention, but then remanded.

If Sundstrand's explanation of rationale were accurate, no reason for remand.

Demonstrated By *Insituform (CAFC 2004)* No Tangential Relation Result is

- Also involved dependent claim rewritten in independent form
- Prior art had nothing to do with disputed limitation (the number of cups)
- Patentee did not separately explain the addition of the single cup limitation
- prosecution history of any relationship between process, which is the alleged equivalent in this Rebuttal established because "no indication in the narrowing amendment and a multiple cup case." (385 F. 3d at 1370).